



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

BIRCH STEWART KOLASCH & BIRCH LLP
PO BOX 747
FALLS CHURCH VIRGINIA 22040-0747

In re Application of
Minami et al.
Application No. 09/481,391
Filed: January 12, 2000
Attorney Docket No. n/a

COPY MAILED

SEP 5 2001

OFFICE OF PETITIONS

AND

CORRECTED DECISION
ON PETITION AND
NOTICE OF MISSING PARTS

In re Application of
Minami et al.
Application No. 09/887,665
Filed: January 12, 2000
Attorney Docket No. 0925-0154P

The decision of July 17, 2001, in application No. 09/481,391 contained a typographical error in the filing date to be accorded the '391 application. Further, the decision did not take into consideration that the examination of the English language papers originally filed in the '391 application had commenced by way of the Office action of November 22, 2000.

Accordingly, the decision of November 22, 2000 is **vacated**.

The petition under 37 CFR 1.182 filed April 9, 2001, in the '391 application and resubmitted April 23, 2001 to disregard the originally filed English language papers in the '391 application is being treated as a petition to accord a filing date of January 12, 2000 to Japanese priority document 11-079518 present in the USPTO on that date as a separate application filed under 35 USC 111(a) and 37 CFR 1.53(b) in a language other than English, which claims benefit of Japanese 11-079518 filed March 24, 1999.

So construed, the petition is granted.

The originally filed declaration does not execute the current specification, and only

executes the incorrect English language papers filed on January 12, 2000. The substitute declaration filed with the petition executes application No 09/481,391. Accordingly, since no declaration yet filed executes the application papers present on filing in the '665 application, this application is considered to have been filed without an oath or declaration. Applicant is given TWO MONTHS from this mailing to file an oath or declaration specifically identifying application No. 09/887,665, filed January 11, 2000, and also submit the fee for late completion of an application, both Addressed to Box Missing Parts. Extensions of time are available under 37 CFR 1.136(a).¹

In essence, petitioner's seek relief from their inadvertent error in submitting an English language specification, drawings, and claims in the '391 application on January 12, 2000 that did not correspond to the Japanese priority document that was also present in the '391 application on that date, so that they can retain the filing date of January 12, 2000 for an original English language application that corresponds to the Japanese priority document. Inspection of the certified translation of the Japanese priority document that was submitted with the petition reveals that the Japanese language priority document, present in the USPTO on January 12, 2000 included a specification, all drawings referenced in that specification, and at least one (3) claim(s). As such, applicants are entitled to a filing date of January 12, 2001 based on the non-English specification represented by that priority document. This decision grants the requested relief, subject to certain conditions noted *infra*.

Pursuant to 37 CFR 1.182, this favorable decision may be, and is, conditioned on the requirement that the Japanese priority document be transferred to a new file wrapper which has been assigned application No. 09/887,665, and accorded a filing date of January 12, 2000. This is particularly so in this case as the English language papers that were present on filing (albeit incorrectly submitted) were processed by the USPTO and properly accorded a filing date and *ex parte* examination has already ensued on the claimed invention presented by those papers. Further, as pointed out at 65 *Fed. Reg.* 50098 (Aug. 16, 2000) the basic filing fee did not cover the Office's costs of processing and examination of the '391 application, which were incurred by applicant's filing error. It also should be noted that *inter alia*, 37 CFR 1.145 renders it problematic as to whether the examination in the '391 application could properly continue on the merits of the newly presented claims to the correct invention, after issuance of an Office action on the merits of the originally claimed (in English) invention.

The originally filed English language papers have been retained in the '391 file.

¹ Petitioner may also wish to submit an assignment, under separate cover to Assignment Branch, that specifically identifies application No. 09/887,665 filed January 11, 2000.

The priority document, and all the subsequently filed English language papers have been transferred to the '665 application file, and the filing fees charged as authorized in the petition.

Application No. 09/481,391 is being returned to Technology Center AU 2614, for further processing as an abandoned application.

Application No. 09/887,665 is being forwarded to the Office of Initial Patent Examination for further processing as an application filed on January 12, 2000, under 35 USC 111(a) and 37 CFR 1.53(b) in a language other than English, using the photocopy of the Japanese priority document, previously prepared by the undersigned, with an indication that, on filing, 3 claims and four sheets of drawings were present. The preliminary amendment of May 22, 2001, has been modified by the undersigned to reflect that it is directed to the '665 application and that original claims 1 through 3 (present in the priority document) have been canceled (not 1 through 10) and that new claims 11 through 17 have been renumbered (pursuant to 37 CFR 1.121), as 4 through 10, respectively.

The marked-up copy of the original (albeit incorrect) English language specification will not be further employed in the '665 application. The examiner is authorized to consider, during examination, pages 1 through 24, and 27 of the English language specification and abstract filed May 22, 2001, as a substitute specification corresponding to the verified translation of the Japanese priority document. The 7 claims appearing on pages 25, 26 have been superceded by claims 4 through 10 of the preliminary amendment of May 22, 2001.

Fees totaling \$820 (the \$690 filing fee due 1/12/00, authorized on the same date in the '391 application and the \$130 fee for filing a non-English specification), have been charged to deposit account No. 02-2448 for the '665 application.

Telephone inquiries related to this decision should be directed to the undersigned. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.


Brian Hearn

Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy